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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/045,386	03/20/1998	JAY S. WALKER	WD2-97-557	9821

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EXAMINER

RUDY, ANDREW J

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 03/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/045,386

Applicant(s)

WALKER ET AL.

Examiner

Andrew Joseph Rudy

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2002 & 06 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11, 14, 25, 26 and 33-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11, 14, 25, 26 and 33-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 March 1998 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Claims 11, 14, 25, 26 and 33-40 are pending.

Drawings

2. The drawings are still objected to per the July 1, 2002 Office Action. Applicant's comments have been reviewed, but are not convincing. Figs. 1 and 2 are different embodiments and are not the same Point of Sale Terminal (POS), as each contains different elements. Correction of the Drawings is required. Failure to respond to this issue will be interpreted as a willful non-response by Applicant.

Claim Rejections - 35 USC §101

3. Claims 11, 25, 33, 35, 37 and 39 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 11, 25, 33, 35, 37 and 39 only recite an abstract idea. The recited steps of measuring an activity rate or receiving an override signal does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of a user or by use of a pencil and paper. These steps only constitute an idea of measuring an activity rate or receiving an override signal. Intended use, e.g. for controlling, if, do not positively recite claim limitations and are given little, if any, patentable weight.

Claim Rejections - 35 USC § 112

4. Claims 11, 14, 25, 26 and 33-40 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

From page 6, lines 11 and 19, terminal 10 has already been disclosed in Fig. 1. It appears it may be terminal 11, but the examiner is not clear on this matter.

From page 6, lines 21 and 22, terminal 10 appears in error. It apparently should read terminals 10 and 11, but the examiner is not clear on this matter.

From page 7, lines 8, 12 and 14, POS 10 appears in error. It apparently should read POS 10 and 11, but the examiner is not clear on this matter.

From page 8, lines 4, 5, 8 and 15, the POS terminal 10 is not labeled and the examiner is not clear on what is being referenced.

From page 9, lines 4, 7, 9, 15 and 17, the POS terminal is not labeled and the examiner is not clear on what is being referenced.

From page 11, lines 4, 8, 11 and 12, the POS terminal is not labeled and the examiner is not clear on what is being referenced.

As is, the claim language in reference to the specification is not clear. No new matter may be entered.

Applicant's REMARKS have been reviewed, but are not convincing. The POS terminals illustrated in Figs. 1 and 2 are each different embodiments with different elements contained in each embodiment. Applicant's disclosure does not clearly illustrate these in the drawings in relationship to the descriptive portion of the specification. As is, it is not clear how Applicant's inventive idea is enabled. Thus, the claim language cannot be clearly ascertained.

5. Applicant's 6 January 2003 Amendment has obviated the rejection under 35 U.S.C. 112, second paragraph and it is hereby withdrawn.

Claim Rejections - 35 USC § 103

6. Claims 11, 25, 33, 35, 37 and 39, as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over "Examiner's Affidavit" by James W. Myhre. Myhre's declaration discloses upselling. Though Myhre does not explicitly define the term "activity rate" (nor does Applicant), it is common knowledge and notoriously old in the commercial transaction world that one sells what one has on hand to monitor or may be able to obtain/monitor, given customer demand/activity rate. To have provided the upsell activity of a commercial transaction based upon monitoring an activity rate would have been obvious to one of ordinary skill in the art, in view of Myhre. Doing such would implement common knowledge upselling techniques.

7. Claims 14, 26, 34, 36, 38 and 40, as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over "Examiner's Affidavit" by James W. Myhre in view of Official Notice.

Regarding claims 14, 26, 34, 36, 38 and 40, Official Notice is taken that using a computer system employing a processor, storage device and monitoring activities are well known and common knowledge in the art. Also, upselling using a computer system is well known in the

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commercial transaction art. Further, it is common knowledge that staff, e.g hotel, will only provide a customer an upsell to a more attractive room if the room is available. Staff monitoring customer demand for the available rooms determines availability.

To have provided the upsell activity of a commercial transaction a computer system employing a processor, storage device and based upon monitoring an activity rate would have been obvious to one of ordinary skill in the art, in view of Myhre and the Official Notice. Doing such would implement common knowledge upselling techniques implemented on well known computer apparatus.

8. Applicant's 4 October 2002 Information Disclosure Statement has been reviewed.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Joseph Rudy whose telephone number is 703-308-7808.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

March 5, 2003

